

Notice of Allowability

Application No.

09/580,515

Applicant(s)

SHORT ET AL.

Examiner

Art Unit

Della M. Ramirez

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/2/2003.
2. ☒ The allowed claim(s) is/are see attached.
3. ☒ The drawings filed on 25 May 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No. _____.
- (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
- (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 3 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 5 ☒ Information Disclosure Statements (PTO-1449), Paper No. 3/4/2003
- 7 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 2 ☐ Notice of Informal Patent Application (PTO-152)
- 4 ☐ Interview Summary (PTO-413), Paper No. _____.
- 6 ☒ Examiner's Amendment/Comment
- 8 ☐ Examiner's Statement of Reasons for Allowance
- 9 ☐ Other

DETAILED ACTION

Status of the Application

Claims 18, 41-79 are pending.

The request for entering amendments to claims 18, 41-44, 46-57, 59-60, 62-65, 67, 70-79, addition of new claims 80-101, and arguments filed on 9/2/2003 under 37 CFR 1.116 in reply to the Final Action Paper No. 17 mailed on 3/25/2003 are acknowledged. The proposed amendments will not be entered since they raise new issues and would require additional search. At a minimum, the new claims would be rejected under 35 USC 112, first and second paragraph. It is noted that the claims 18, 41-79, as amended in response to the Final Action, and newly added claims 80-87 are directed to a method which encompasses different phytases from those encompassed by the method of previously presented in claims 18, 41-79. In addition, newly added claims 88-101 are not directed to the elected invention, i.e. a method to produce a foodstuff comprising the polypeptide of SEQ ID NO:2, but rather to a foodstuff comprising a phytase.

The terminal disclaimer filed on 9/2/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,183,740 and any patent granted on Application Number 09/777,566 and 09/866,379 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The information disclosure statement (IDS) submitted on 3/4/2003 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Examiner's Amendment

1. An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Please replace the paragraph beginning at page 1, line 4 with the following rewritten paragraph.

This application is a continuation-in-part of U.S. Patent Application Serial No. 09/318,528, filed May 25, 1999, now U.S. Patent No. 6,183,740, which is a continuation-in-part of U.S. Patent Application Serial No. 09/291,931, now U.S. Patent No. 6,190,897, filed April 13, 1999, which is a continuation of U.S. Patent Application Serial No. 09/259,214, now U.S. Patent No. 6,110,719, filed March 1, 1999, which is a divisional of U.S. Patent Application Serial No. 08/910,798, now U.S. Patent No. 5,876,997, filed August 13, 1997, all of which are hereby incorporated by reference in their entirety.

Reasons for Allowance

3. The following is an Examiner's statement of reasons for allowance. While the claims submitted on 9/2/2003 have not been entered for the reasons set forth above, submission of the terminal disclaimer is deemed sufficient to overcome the double patenting rejections previously applied to claims 18, 41-79 as of 3/25/2003, which is the mailing date of the Final Action. The Examiner has found no teaching or suggestion in the prior art directed to a method of producing

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a foodstuff containing the phytase of SEQ ID NO: 2. Therefore, claims 18, 41-79, as of 3/25/2003, directed to a method to produce a foodstuff containing the phytase of SEQ ID NO: 2, are allowable over the prior art of record.

4. Claims 18, 41-79 as of 3/25/2003, which is the mailing date of the Final Action, are allowed.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
October 18, 2003

Rebecca Ford
RECEIVED
FEBRUARY 11 2004
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